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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,313	10/15/2003	Christopher E. Cunningham	FMCE-P040A	7813

7590 04/14/2004  
Henry C. Query, Jr.  
504 S. Pierce Avenue  
Wheaton, IL 60187

EXAMINER

KEASEL, ERIC S

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/687,313

Applicant(s)

CUNNINGHAM, CHRISTOPHER E.

Examiner

Eric Keasel

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 2-8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Independent claim 1 is drawn to a combination of a tubing hanger, tubing spool, elongated body, closure member, etc.; however, dependent claims are drawn to a closure member only and do not include every limitation (e.g. the tubing hanger, tubing spool, elongated body, etc.) of the claim on which it depends (see MPEP 608.01(n)(II)).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is drawn to a combination of a tubing hanger, tubing spool, elongated body, closure member, etc.; however, dependent claims appear to be drawn to a closure member only and do not include every limitation (e.g. the tubing hanger, tubing spool, elongated body, etc.) of the claim on which it depends. It is vague and indefinite as to whether claims 2-8 are meant to be drawn to the same combination with further limitations or not. If applicant intends each of the dependent claims to be drawn to the combination, it is suggested that applicant amend the dependent claims to read --The combination as set forth in claim X, further comprising--.

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Claim 4, line 4 recites "a conduit", which appears to be a double inclusion of "a conduit" in claim 1, lines 14 and 15. It is vague and indefinite as to whether this is meant to be the same conduit or a separate and distinct conduit. If they are meant to be separate conduits, then further recitations to "the conduit" are indefinite as it is unclear which one is being referred to.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-5 and 7 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Schreuder (US Patent Number 396,239).

If the dependent claims are meant to be directed to the closure member set forth in claim 1, lines 5-15 only, then Schreuder anticipates claims 2-5 and 7 since Schreuder discloses a reciprocating gate (3) with three flow ports, two of which communicate with two branches (8, 9) (compare Schreuder, fig. 1 and application, fig. 2). The gate is connected to separate pistons that are actuated by fluid pressure to move the gate in opposite directions.

6. Claims 2-6 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (US Patent Number 3,104,659).

If the dependent claims are meant to be directed to the closure member set forth in claim 1, lines 5-15 only, then Smith anticipates claims 2-6 since Smith discloses a gate valve (18) for controlling the flow of fluid through a component having a fluid flow passage that includes at least a first branch (29) and a second branch (17), the gate valve comprising: a gate cavity (18)

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which communicates with both the first branch and the second branch; a gate (37) which is movably positioned in the gate cavity and which includes a first flow port (shown in communication with branch 29) that is connected to a second flow port (the straight region denoted with ref. no. 38); and means (21, 22, 23) for actuating the gate between an open position (shown in the Fig.), in which the first flow port is aligned with the first branch and the second flow port is in communication with the second branch, and a closed position, in which the first flow port is offset from the first branch; wherein the second flow port is approximately perpendicular to the first flow port; and wherein the gate comprises a third flow port (shown in communication with branch 17) which is connected approximately perpendicular to the second flow port and which is aligned with the second branch when the gate is in the open position; wherein the actuating means comprises: a piston (41) which is connected to the gate and which sealingly engages a conduit (21) that extends from the gate; and means (22, 23) for conveying hydraulic pressure to a first portion of the conduit to thereby move the gate in a first direction; wherein the actuating means further comprises mechanical biasing means (42) for moving the gate in a second direction which is opposite to the first direction.

*Allowable Subject Matter*

7. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action, with respect to the conduits. Claims 2-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, if the claims are directed to the combination set forth in claim 1, further comprising...

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8. The following is a statement of reasons for the indication of allowable subject matter:

Although the subcombination closure member is well known, the prior art of record does not disclose or suggest the closure member set forth in claim 1, lines 5-15 in combination with a tubing hanger which is suspended in a tubing spool and which comprises an elongated body having an annulus bore that extends generally longitudinally therethrough, the annulus bore comprising at least a first branch which is in fluid communication with a second branch.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Petersen, Hopper, and Watkins et al. disclose similar devices.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Eric Keasel 9 APR 04*

Eric Keasel  
Examiner  
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